

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: )  
P.C. Blank et al )  
 )  
 ) Art Unit: 1772  
Application No.: 10/804,953 )  
Confirmation No: 8082 ) Examiner: Nordmeyer, P.  
 )  
Filed: 03/19/2004 )

Title: Columnar Adhesive Label Roll

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**  
**AMENDED APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the office action dated 02/23/2007 entitled "Notification of Non-Compliant Appeal Brief," Applicants submit this amended appeal brief for resolving the objections raised by primary examiner N. Ahmad in behalf of examiner P. Nordmeyer, of record.

The amendments made to the brief are being submitted without prejudice to resolve the objections and promote the expeditious prosecution of the appeal in the already protracted prosecution; and with traverse since the examiner's objections are unwarranted and unsubstantiated.

The objected-to Background section has been removed from the examiner's contention of "proper order of the headings," and relocated under the Argument section.

The "three paragraphs at the end of the [summary] section" have been removed therefrom and also relocated to the Argument section.

The clearly optional "subheadings" have been added under the four ground-of-rejection headings.

The MPEP 706.02(j) "subheading" objected to by the examiner on page 16 of the brief has been deleted.

These changes are being made in good faith to resolve the vague objections presented in boxes 1, 4, 6, and 10 of the 02/23/2007 office action, and now permit this appeal to be decided de novo by the Board.

In accordance with 37 CFR 41.37, applicants hereby submit this Appeal Brief and request that the decision of the examiner dated 12/08/2006 finally rejecting claims 1-29 and 31 be reversed and that these claims be allowed.

**REAL PARTY IN INTEREST**

The real party in interest is the assignee, NCR Corporation.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**STATUS OF CLAIMS**

Claims 1-29 and 31 stand pending in the application.

Claims 30 stands canceled, without prejudice.

Claims 1-29 and 31 stand finally rejected and are the subject of this Appeal Brief.

**STATUS OF AMENDMENTS**

There is no amendment filed subsequent to the final rejection.

**SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 1 recites a label roll 18 in the form of a web 20 having a front surface 34 and an opposite back surface 36 wound longitudinally along a running axis 32 to provide a plurality of labels in the roll.

The basic label roll 18 is shown one embodiment in figures 1-4, and described in paras. 23-28 at page 3, line 19 - page 4, line 24.

The back surface 36 includes a plurality of noncontiguous adhesive patches 38 spaced longitudinally apart in a column of adhesive isolated on one side only of the transverse middle of the web 20 in a minor area of the back surface, with the remaining area of the back surface being devoid of adhesive and including adhesive-free spaces transversely bridging the web longitudinally between the adhesive patches to isolate the patches in sequential labels and permit cutting of the web in the adhesive-free spaces to separate the labels.

These features are shown in figure 4 and described at paras. 29 et seq, at page 4, ll. 25+.

The front surface 34 includes a release strip 40 extending along the running axis 32 behind the column of adhesive patches 38, and laminated to the patches in successive layers in the roll, with the patches 38 being sized for bonding an individual label to a surface.

These features are also shown in figure 4, and described at paras. 31 et seq, at page 5, ll. 8+; and figure 1 shows the individual label printed, cut, and applied to the package 14.

Independent claim 19 recites similar features for specific cooperation with the printer 10 and its cutting blade 28 as shown in figures 1-3 and described at paras. 21 & 22 on page 3, ll. 11+; and paras. 35 & 40 on page 6, ll. 2-31.

The individual labels 12 and adhesive patches 38 have a preferred cooperation to permit cutting of the web by the blade 28 in the adhesive-free spaces.

Independent claim 31 recites another embodiment of the label roll 18 in which the web 20 is imperforate and the web 20

including a train of longitudinally separated identical adhesive patches 38 on one surface 36 and a different release strip 40 on an opposite surface 34 behind the train, with the patches 38 being aligned in a single column along only one lateral edge of the web to define corresponding labels 12 each having a minor adhesive patch isolated inboard in a surrounding adhesive-free remainder of each label, with the adhesive-free remainder transversely bridging the web longitudinally between the patches to permit adhesive-free cutting of the web to separate the labels.

This embodiment is also illustrated in figures 1-4, and described in the specification at the above-identified paragraphs.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground (1) - whether claims 1-9, 11-15, 17, and 18 are unpatentable under 35 USC 103(a) over Smith and Slagsvol?

Ground (2) - whether claims 10 and 16 are unpatentable under 35 USC 103(a) over Smith, Slagsvol, and Lane?

Ground (3) - whether claims 19-25, 27-29, and 31 are unpatentable under 35 USC 103(a) over Smith and Slagsvol?

Ground (4) - whether claim 26 is unpatentable under 35 USC 103(a) over Smith, Slagsvol, and Lane?

ARGUMENT

In the fast food industry specialty labels may be used in identifying individual food products in typical sales transactions in which individual labels are printed and cut from a continuous label roll.

The typical pressure sensitive adhesive label includes full surface adhesive on its back side which may interfere with the handling thereof during the food preparation process.

An individual label identifying the corresponding food product is removed from the printer by the user who typically wears sanitary gloves. The label may inadvertently bond to the gloves, and this increases the difficulty of placing the label on the packaging for the intended food product.

Linerless label rolls have a front surface coated with a suitable release material, such as silicone, for providing an integrated liner in the web itself without the need for an additional liner sheet.

However, as the linerless web is unwound in the printer, the back side adhesive is exposed to the various parts of the printer and can inadvertently bond thereto leading to undesirable jamming of the printer.

The printer may include a typical cutting knife or cutting bar for cutting individual labels from the continuous web. The exposed adhesive on the linerless label roll therefore permits adhesive buildup on these cutting elements during prolonged operation of the printer.

Adhesive buildup on any of the various components of the printer contacting the adhesive side of the label is undesirable because it requires periodic cleaning or other maintenance to avoid printer jamming, which may nevertheless occur.

The summary section above introduces the three independent claims 1, 19, and 31 now being addressed in this appeal.

The columnar adhesive label roll recited in these three independent claims provides specialty labels having special adhesive patterns for solving the problems expressly disclosed in the Background of the specification.

In the fast food industry, the labels reduce or eliminate adhesive build-up in the printers, and minimize interference in quickly filling food orders by workers wearing gloves.

The various dependent claims recite additional features having additional benefits presented in the specification, and further addressed hereinbelow.

There have now been five office actions on the merits, and three telephonic interviews, and the examiner has expended extraordinary scrutiny in examining the various claims; and has broadly interpreted both the various claims and the references of record.

However, the examiner has failed to allow even one claim based on broad interpretations, which will correspondingly increase the scope of the claims upon eventual allowance when due weight is given to the specific elements recited and the specific cooperation thereof which well distinguish over the references being applied.

Applicants continue to traverse the examiner's rejections as failing to comply with applicable MPEP provisions and Section 103 requirements, and wanting suitable evidence in support thereof.

The examiner has made repeated assertions or mere examiner argument, without legal support and without evidentiary basis; and mere examiner assertion is never evidence, and cannot a rejection support.

Ground 1

Ground (1) - whether claims 1-9, 11-15, 17, and 18 are unpatentable under 35 USC 103(a) over Smith and Slagsvol?

Applicants traverse the repeated rejection of these claims as found in para. 4 of the final office action, and request reversal of this rejection.

The examiner has repeated in most part verbatim at para. 4 bridging pages 2-5 of the final office action the previous contentions found in para. 6 of the last office action.

And, in response to Applicants traverse of these rejections, the examiner has added para. 9 for "response to arguments,"

addressed in detail hereinbelow.

It is noted that para. 6 in the previous office action additionally listed claims 19-25 and 27-29 under this rejection, which have now been removed by the examiner and presented in para. 7 as a new rejection using the same two references. This rejection is later addressed.

Firstly, Slagsvol relates neither to Applicants' field of endeavor of pressure sensitive printing labels, or to Applicants' many problems in the specialty labels used in the fast food industry, and is therefore nonanalogous art.

The field of endeavor in Slagsvol is expressly stated at col. 1 thereof and is in general graphic arts, and specifically tracing paper for duplicating graphic arts.

Neither graphic arts nor tracing paper duplication match the field of endeavor of printing labels.

The problems in Slagsvol are presented at col. 1, ll. 11-25 and include time delays in taping tracing paper, and the loose fit thereof, along with undesirable tearing of the tracing paper; none of which are relevant to Applicants' problems.

Applicants correctly predicted that the examiner would attempt to recharacterize the express field of endeavor and problems stated in Slagsvol in the belated attempt to force reference Slagsvol to apply, but this is not permitted by the MPEP and case law therein.

The examiner's attempt at page 11 to cite Oetiker fails to establish the threshold requirement for similar facts, and fails to consider the relevant case law in toto. The examiner has merely applied MPEP 2141.01(a) for the general heading of non-analogous art without due evidence and analysis.

The scope of the prior art may be determined from applying In re Wood and Eversole, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA, 1979):

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor.

If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

The examiner is not permitted to recharacterize the applicant's problem in an attempt meet this test. In *Ex parte Dussaud*, 7 USPQ2d 1818 (BPAI 1988), the Board cites the Woods case, among others, and states that:

We also find that the examiner's characterization of the problem ... is broader than the particular problem with which the appellants were involved. Precise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the same token, defining the problem too broadly, as done here, may result in considering prior art as "analogous" which is inconsistent with real world considerations. .

The Federal Circuit in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) provides further guidance in applying the Wood test that:

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness .... By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art.

*Oetiker*, like Wood before it, presents the basic test for nonanalogous art, and it is quite conspicuous that the examiner has overlooked and failed to address Applicants' presentation of the facts found in the claims and in *Slagsvol*.

Instead of addressing the specific facts supporting the different fields of endeavor and the different problems, the examiner has instead recharacterized the holdings of *Oetiker* for a plain dictionary definition, when *Oetiker*, being applied by the examiner, does not support the use of the plain dictionary, "www.webster.com," being used by the examiner in the misplaced attempt to fit *Slagsvol* as somehow relevant to one skilled in the applicable label art.

The examiner bootstraps the ultimate holding of *Oetiker* by first defining a "label" quite generally, and then simply asserting that: "Slagsvol becomes a label the moment a mark is made on the surface of the tracing paper and the paper is stuck to

the surface of an object."

But, where in Oetiker is the legal support for this bald examiner assertion?

Of course, even a multi-ton naval aircraft carrier could also be considered a "label" as defined by the examiner, as soon as an errant sailor were to scrawl graffiti over the metal superstructure thereof which is stuck to the underlying steel frame.

What then is the practical limit to the examiner's novel definition and use of label?

Tracing paper is tracing paper and is not characterized or used as any label relevant to the industrial label art, or to Applicants' claims, or to Smith.

Only this examiner attempts to recharacterize it as so.

"Stuck to the surface of an object" the examiner opines in hindsight, thereby creating an overly broad definition of label, and perhaps a sticking problem due to the different adhesives.

Yet, the examiner overlooks that in use the tracing paper is first affixed to the underlying sheet, then the tracing is done, and then the tracing paper is torn from its adhesive borders 9a,b.

Is the Mona Lisa painting a "label" according to the examiner's definition since it has paint on a substrate and the substrate is attached to a frame and to the wall upon which it hangs?

The examiner's mere definition of "label" is overly broad, and necessarily disregards the entire USPTO classification system and the associated fields of search and fields of classification in the hindsight attempt to establish analogous art where it is not found.

Indeed, MPEP 2111.01 although allowing the examiner to interpret claims broadly, also mandates that the examiner afford "plain meaning" to claim terms, which refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art.

The "webster" dictionary is not one skilled in the art.

To the contrary, an entire "Glossary of Terms" book for the pressure sensitive labels is published by the Tag and Label

Manufacturers Institute, Inc., Iowa City, IA, copyright 1992, and contains 67 pages of definitions.

At page 32, the Label Manufacturers Institute presents the definition of "label" as: "The functional portion of a pressure sensitive construction comprising the face material and adhesive, die cut into various shapes."

This definition does not include mere "tracing paper" which clearly has a different construction and definition.

What is the definition of "tracing paper" according to the examiner's use of webster.com?

Main Entry: tracing paper

Function: noun

: a semitransparent paper for tracing drawings; also : a thin paper containing a clothing pattern to be transferred to fabric (as through carbon paper) by tracing

Are the "labels" found in Applicants' claims and in Smith "semitransparent" or used for "tracing drawings"?

Of course not.

Are those "labels" thin paper containing a clothing pattern to be transferred to fabric?

Of course not.

The examiner has conspicuously distorted the definition of "label" to apply to the disparate tracing paper of Slagsvol; but it is equally conspicuous that the examiner failed to provide the corresponding definition of "tracing paper" because that is evidence in and of itself that tracing paper is not a label, as would be known by those skilled in the relevant label art.

Skilled in the art? What significance should be afforded to that term by the PTO?

The examiner's repeated assertions and rejections have continually failed to afford due weight to the skilled artisan apparently due to the perceived simplicity of the label art.

However, the label art is quite esoteric and sophisticated, and is quite crowded with many patents.

To equate the tracing paper of Slagsvol with the labels of Smith is mere examiner assertion divorced from technical reality, and is typical hindsight PTO practice.

The MPEP is commendable for its exhaustive coverage of patent laws, rules, and case law; and the requisite analysis thereof is

similarly exhausting.

But due regard to the various MPEP provisions, including the tests for nonanalogous art, will support the inapplicability of the Slagsvol reference for its tracing paper teachings having no nexus or bearing on the label art, or the specialty labels recited in Applicants' claims, or the disparate labels disclosed in Smith.

Wood, Dussaud, and Monarch are only three, of many, legal cases relevant to evaluating Slagsvol and its tracing paper, but the examiner has failed to address the holdings of these cases, and has failed to provide any other legal basis to support the bald contention regarding the generic label.

Why then has the USPTO classified Slagsvol and Smith in different art and search classes if they both relate to common "labels" as those skilled in the art would recognize?

Where in Slagsvol is any evidentiary basis that the tracing paper could be considered a "label" relevant to Applicants' claims and relevant to Smith, which is quite different?

And, where in Slagsvol has the examiner identified any "problem" which would be relevant to labels, which would be relevant to Applicants' claims, and which would be relevant to Smith?

The protracted prosecution of the present application contains ample evidence of the examiner's various failures to consider the claims and the references in the whole, and the examiner's remarkable ability to constantly change rejections with the substantial advantage of PTO hindsight.

What evidence has the examiner presented that one skilled in the label art relevant to Applicants' claims and Applicants' problems, and relevant to Smith, would also have uncovered Slagsvol in the first instance in any attempt to find relevance with the problems of Smith?

Fundamental to the analysis is problem solving. The examiner, on behalf of one skilled in the art, must provide evidence of problems or other reason to combine based on legal motivation, and the examiner has failed to identify any problem in Smith for which any solution from the tracing paper of Slagsvol would have been relevant.

To permit the examiner to simply present a generic definition of "label" without regard to the stringent classification system of the PTO, and without regard to the case law cited above, to redefine the "tracing paper" of Slagsvol as a "label" appears to be a clear abuse of process since neither the cited case Oetiker, nor the corresponding MPEP provision, supports such a position to force Slagsvol as analogous art, when, to the contrary, it is not.

Since Slagsvol is nonanalogous art, it lacks requisite teachings to support any rejection of Applicants' claims; and therefore, the various rejections under Section 103 are unwarranted and should be withdrawn.

The protracted history of this application is evidence of the inordinate attention to the various claims being made by the examiner, including repeated updates of the search. Rule 104 mandates thoroughness of examination and searching, and the examiner's last update of the search is evidence of the lack of relevant references in the relevant art for use in rejecting the claims.

Not only is reference Slagsvol nonanalogous art, but the express disclosure thereof teaches away from the many claims now being rejected by the examiner.

It is clear that the examiner is applying Slagsvol not for its whole teachings, but for isolated features thereof in an attempt to fabricate new rejections of the claims using the previously applied reference Smith.

MPEP 706.02(j) provides the basic requirements which must be provided by the examiner in establishing prima facie obviousness under 35 U.S.C. 103. Four steps are required of the examiner including:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at

the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Citing Ex Parte Clapp, the MPEP places the burden of proof on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

It is the examiner who must meet this initial burden by applying specific evidence; and clearly the examiner has not met this burden with the unsupported "therefore" and "for the purpose" conclusions of obviousness, which fail to meet the stringent "legal motivation" requirements of MPEP ch. 2100.

The lengthy para. 4 of the office action thrice repeats substantially verbatim the examiner's previous contentions regarding Smith, and merely substitutes the new Slagsvol reference for the Lane reference previously overcome.

In that previous traverse, the many shortcomings and errors in the examiner's description of Smith were identified, and although that traverse was effective for overcoming the Smith/Lane rejection, the examiner has overlooked that traverse in fabricating the new rejection using the simple expedient of

copying the previous remarks.

MPEP 707.07(f) mandates that the examiner answer the substance of Applicants' traverse, and in that regard the examiner has clearly admitted the inapplicability of Smith by the withdrawal of the previous rejections based thereon.

The fundamental failures of Smith have now been expressly acknowledged repeatedly by the examiner in withdrawing the previous rejections based thereon, and is now evidence of record against the final combination thereof with Slagsvol.

As previously indicated in the last two amendments, and now being repeated a third time herein, many of the examiner's contentions regarding Smith are unsupported by any evidence therein; and notwithstanding the second and third opportunities for the examiner to correct those contentions, the examiner has not.

Instead, the examiner continues to rely on the same, and erroneous, statements made in the previous office actions, and now yet again repeated in the latest office action.

It is well recognized that label art is not only quite crowded, but has limited elements therein which necessarily must be repeated in drafting claims of correspondingly different scope to meet the patentability requirements of Sections 102 and 103.

Labels, webs, adhesive, release, die cuts, perforations, etc are notoriously well known in the label art, yet the present claims recite different and improved combinations of selected elements for a specific function and specific use not found in the references of record, including Slagsvol and Smith.

Most significantly, is the basic failure of Smith to disclose or suggest a plurality of discrete adhesive patches 38 arranged in a specific column.

CLAIMS 1 and 19

Independent claims 1 and 19 have been presented in detail in the summary section.

Both claims recite a column of adhesive patches 38 with adhesive-free spaces transversely bridging the web 20

longitudinally between the adhesive patches 38 to isolate the patches in sequential labels 12 and permit cutting of the web in the adhesive-free spaces as shown in figures 3 & 4 for example for creating the corresponding specialty labels 12.

In other words, these claims require specific adhesive patches and specific adhesive-free zones therebetween which cooperate in the specialty labels for the benefits presented in the specification for permitting cutting of the web without excessive adhesive buildup in the printer or on the cutting blade.

These features are expressly recited in these two independent claims 1 & 19, and the MPEP mandates that the examiner afford due weight thereto, but the examiner has not.

For the first time in the protracted prosecution, the examiner admits at page 11 that "certain features" have not been afforded any weight because the "specialty labels used in the fast food industry are not recited in the rejected claim(s)." The examiner cites Van Geuns.

However, the examiner has failed to identify any claim for which the examiner has failed to afford such weight.

And, the examiner has misapplied both Van Geuns, and the relevant provisions of MPEP ch. 2100 on the "whole" analysis of the claims.

MPEP 2141.02 cites case law, including *In re Antonie* for example, for the "As a Whole" inquiry which the examiner must perform:

In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification ... Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. 103.

The examiner's bald contention is quite erroneous on its face, since each and every claim indeed recites a specialty label by express recitation of the label roll, and its web, and its specific construction with adhesive and release thereon to define

the labels expressly recited therein.

What weight should the examiner give to the term "specialty label" if that term was used in the claims.

That is not the issue.

The issue, and the relevant examination, is what elements are expressly recited in the claims and in what combination and for what purpose or function, and what is the "whole" to be attributed thereto.

The examiner has found Van Geuns in MPEP 2145, but has failed to establish the requisite factual similarity. That case applies to limitations found only in the specification, but not recited in the claims.

Those facts are inapposite to the examiner's contentions regarding specialty labels, and the examiner has admittedly failed to evaluate the claims in the whole in the guise of specialty labels "not recited in the [unidentified] claim(s)."

To be certain, the various claims do indeed recite specialty labels with the recited features thereof.

There can be no doubt of what each claim recites, and each claim indeed recites labels.

The examiner is confusing affording due weight to claims and their features in the whole for features not recited in the claims.

The claims need not recite their benefits or attributes, but those benefits and attributes must nevertheless be afforded due weight under the whole analysis, and the examiner's own comments clearly indicate the failure to afford any weight whatsoever in the guise of Van Geuns, which is inapplicable as a legal expedient.

MPEP ch. 2100 is replete with the significance of evaluating the claims in the "whole," see MPEP 2141.02 & 2106 in particular, and clearly overlooked by the examiner in the hindsight rejection of the claims without due weight being afforded thereto.

The examiner is clearly evaluating the individual claims for naked elements, and then attempting to find corresponding naked elements in the references, and then asserting obviousness in hindsight, fabricating reason after reason, without regard to the

proper application of both the MPEP provisions and case law, and, especially, evidence.

At page 11, the examiner has admittedly failed to afford due weight to certain claim features, but has failed to identify which, and now leaves to speculation which features and which claims are being addressed. This is clear error; and reason in and of itself to reverse the various rejections.

And, quite significantly, is the examiner's failure to afford due weight to the specific adhesive patches 38 and cooperating adhesive-free spaces therebetween recited in the claims.

At page 3 of the office action, the examiner references "Column 3, lines 42-46" in Smith for support for these features, but this clear error has been previously brought to the examiner's attention.

At page 11, the examiner attempts to explain these errors following Applicants' previous traverse, and following Applicants' previous explanation of the clear teachings of Smith. But, the examiner's contentions are mere assertions, without any evidentiary support in the Smith, and without due regard to the different recitations in the claims.

What does Smith teach to one skilled in the art?

The adhesive in Smith is introduced at col. 3, line 56; and is applied in narrow strips 34,35 "preferably substantially continuous strips."

Although at col. 3, 11. 66+, Smith states that "other patterns can be applied ... or discontinuous depending upon the particular type of adhesive ...," there is no figure of such other patterns, no description thereof, and no teaching of any pattern relevant to the specific adhesive columns recited in Applicants' claims, or relevant to the disparate configuration of Slagsvol.

Indeed, the examiner repeatedly cites "Column 3, lines 42-46" which in turn describes "The patterns 27,28 ... illustrated in FIG. 3" of Smith for the "plurality of non continuous adhesive patches," but that figure 3 does not show the adhesive 34,35, but instead shows the silicone patterns 27,28.

This blatant error was brought to the examiner's attention in the third and fourth amendments, yet the examiner has failed to

correct this error, which error wholly undermines the examiner's rejections.

The examiner's further contentions at page 11 still fail to explain how any such teaching of Smith is specific to the discrete adhesive patches arranged in a column with intervening adhesive-free spaces as recited in Applicants' claims.

The fundamental teaching of Smith, at col. 3, ll. 62+, is continuous adhesive strips 34,35 along both edges of the substrate 12.

The incidental teaching of Smith, at col. 4, ll. 1+, is that the adhesive "patterns 34,35 may be continuous or discontinuous depending upon the type of adhesive used and how securely the final label 11 must be attached to the substrate in final use."

Yet, Smith fails to further explain what "discontinuous" patterns are contemplated, leaving that to speculation; except for type and strength, additionally not explained.

At col. 3, ll. 42+, Smith teaches that silicone patterns 27,28 are preferably continuous, although they might be "discontinuous strips, dots, a series of polygons, or a wide variety of other patterns," yet again without any figures or explanation.

The examiner cannot rely on the lack of teachings here to support rejections of specific configurations in Applicants' claims; and that is what the examiner has done.

What is a discontinuous strip?

What is the dots form?

What does the series of polygons look like?

What is the wide variety of other patterns?

Why use the different embodiments?

And, how would those different embodiments have been used relative to the adjoining labels 11 shown in figure 3 of Smith, and delineated by the perf lines 21?

The teachings for silicone are not relevant to the adhesive in Smith, so where is the evidence in Smith of any pattern matching the patterns recited in Applicants' claims?

Col. 4, ll. 1+, is the only apparent teaching for the adhesive strips, which would be continuous except for adhesive

type and strength.

Where then is any teaching or suggestion that the continuous adhesive strips shown in Smith would have been modified by one skilled in the art into the specific columnar form recited in Applicants' claims including independent claims 1 & 19 being rejected by the examiner?

As MPEP 706.02(j) mandates, "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

Clearly, Smith does not illustrate, disclose, or suggest the columnar adhesive patch configuration recited in claims 1 and 19.

At page 3 of the office action, the examiner has initially applied Smith, alone, for anticipating certain features of independent claims 1 & 19, including the patches and adhesive-free spaces based on the col. 3, 11. 42-46, reference, but that reference, as indicated above requires speculation as to the form of the alternates.

It has been held that anticipation of features cannot be made on mere conjecture (*W.L. Gore & Associates, Inc., v Garlock, Inc.*, 220 USPQ 303, 314, Fed. Cir., 1983, 721 F.2d 1540, cert. denied, 469 U.S. 851 (1984)).

Furthermore, it is stated in *General Tire & Rubber Co. v Firestone Tire Co.*, 174 USPQ 427, 442-443, D.Ct., Ohio, 1972, affirmed in part, 180 USPQ 98, Ct. Ap., 6th Cir., 1973, 489 F.2d 1105, that:

"The standards of anticipation are strict. The invention must be disclosed within the four corners of a single reference. If a reference is silent or ambiguous with respect to an element of the invention, that gap cannot be filled by assumption or by combining one reference with another. An anticipating reference must teach the invention; it is not sufficient to point to its silence or ambiguity after the invention and argue that the invention could be made out from reference."

Clearly, Smith does not expressly teach the specific forms of the alternate patterns, nor does it expressly teach, or suggest,

the specific form of columnar adhesive recited in Applicants' claims.

Claims 1 & 19 recite not only the column of adhesive patches 38, but also that they are isolated in sequential labels to permit cutting in the adhesive-free spaces.

Where is this disclosed or suggested by Smith or Slagsvol, and where has the examiner presented any reasoning, let alone a convincing line of reasoning?

The adhesive strips 34,35 shown in figure 2 of Smith are clearly continuous from label 11 to label 11, shown in figure 3.

If the adhesive strips 34,35 were "discontinuous" how would that look? Discontinuous longitudinally or discontinuous transversely or discontinuous diagonally?

And then, how would that discontinuous pattern be found from label to label? Would there be an adhesive-free space between the labels 11?

These are questions relevant to the Section 103 analysis which the examiner has overlooked in the rush to reject based on mere generalities and mere examiner assertion, without due regard to the stringent requirements under Section 103.

Similarly, if the adhesive strips 34,35 were "dots" how would that look? A single row of tiny dots? Multiple rows of tiny dots? Rows arranged longitudinally or transversely or diagonally?

And then, how would that dot pattern be found from label to label? Would there be an adhesive-free space between the dots and labels 11?

If the adhesive strips 34,35 were "a series of polygons" how would that look? What shape polygon? In what series? Series arranged longitudinally or transversely or diagonally?

And then, how would that polygon pattern be found from label to label? Would there be an adhesive-free space between the polygons and labels 11?

Even more speculation is required for the "wide variety of other patterns" disclosed by Smith.

And, claims 1 & 19 further recite that the patches are noncontiguous which is clearly not the same as "discontinuous strips, or dots, or series of polygons, or other patterns."

In all of the patterns disclosed by Smith, the adhesive would just as likely be contiguous to ensure a "secure" attachment of the final label to the substrate, and the examiner has not shown otherwise.

The only teaching relevant to the adhesive strips in Smith is expressly found at col. 4, and is specific only to "type of adhesive" and ability to "securely ... [attach]" the label to the substrate.

The examiner simply contends that the general disclosure of a variety of shapes for the silicone patterns, and thereby the adhesive strips in Smith, would per se render obvious any and all patterns thereof, without regard to the specificity of the patterns and without regard to the cooperation thereof in the recited labels.

This is clear error under Section 103 which mandates an evidentiary basis to support features and variations thereof; and legal motivation for specific changes, clearly overlooked by the examiner in the rush to reject the claims based on generalities, and not specifics.

The examiner next admits at page 4 the fundamental shortcoming of Smith which "fails to disclose the patches being isolated on one side only of the transverse middle, being aligned on one lateral edge of the web and closer thereto than an opposite edge . . . , along with other shortcomings.

Both independent claims 1 and 19 recite the single column configuration of the adhesive on the label roll for the many advantages disclosed in the specification.

In light of this fundamental shortcoming of Smith, the examiner has conducted another search, now into a nonanalogous US classification in an attempt to find naked elements without regard to context.

The newly uncovered reference Slagsvol teaches a disparate tracing paper, configured differently than the linerless labels disclosed in Smith, and used quite differently.

The examiner has failed to establish any structural similarity with Smith to begin with, and then presents the conclusory statement of "for the purpose of forming a paper that

is easily and rapidly applied to a surface (Column 1, lines 42-44)," which is not the legal motivation mandated by the MPEP ch. 2100, nor based on evidence, nor based on evaluating the claims and references in the whole.

The examiner's various comments are evidence of the examiner's failure to afford due weight to the highly esoteric elements mandated by Section 103 in establishing a rejection, and well presented in the MPEP.

The examiner's failure to afford due weight to the whole analysis including "problems" being solved is now directly evidenced by the examiner in the additional comments found at page 12.

In response to Applicants' contention that the examiner has failed to identify any "problem" the examiner merely yet again admits what Smith "fails to disclose...," yet such failings are not the "problems" contemplated by the relevant case law.

What is definition of a "problem" as used in the MPEP, or as found in webster.com?

The examiner merely contends that "Therefore, it would have been obvious ... for the purpose of controlling the adherence of the substrate to a surface."

Yet, this "purpose" is not legal motivation, nor based on any stated problem in Smith, or Slagsvol itself.

In Smith, the main problem is that "a functional printable release material has not been successfully developed," col. 1, ll. 6+.

In Slagsvol, the main problem is "time-consuming" and "loose fit," col. 1, ll. 11+.

So what then is the "problem" this examiner is solving by combining the disparate references Smith and Slagsvol, and where is the evidentiary support thereof, and the requisite legal motivation wanting in the examiner's simplistic assertions?

MPEP 706.02(j) presents the basic standard which the examiner must support, but has not in the examiner's use of mere assertion and hindsight.

In re Dembicza, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), emphasizes the evidentiary showing required by the USPTO in

supporting an obviousness rejection for avoiding impermissible hindsight. The USPTO rejected as obvious claims for a trash bag colored orange in imitation of a pumpkin and decorative face for Halloween. The USPTO cited many references for creating Jack-O-Lantern bags, including conventional plastic lawn or trash bags. The Federal Circuit reversed the obviousness rejections as hindsight-based, and summarized previous cases:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... [In re Rouffet] "the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." [In re Fritch] examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]." [In re Finel] evidence of teaching or suggestion "essential" to avoid hindsight. [Ashland Oil] district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination." [Graham] "strict observance" of factual predicates to obviousness conclusion required. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --- the essence of hindsight. [Interconnect Planning Corp.] "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.... although "the suggestion more often comes from the teachings of the pertinent references...." The range of sources available, however, does not diminish the REQUIREMENT FOR ACTUAL EVIDENCE. THAT IS, THE SHOWING MUST BE CLEAR AND PARTICULAR.... Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence...." In addition to demonstrating the propriety of an obviousness analysis, PARTICULAR FACTUAL FINDINGS REGARDING THE SUGGESTION, TEACHING, OR MOTIVATION TO COMBINE serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the

suggestion, teaching, or motivation to combine the prior art references....

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific - or even inferential - findings concerning the identification of the relevant art, the nature of the *PROBLEM* to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references *CAN* be combined to read on the claimed invention. For example, the Board... concludes that the *SUBSTITUTION* of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an *OBVIOUS DESIGN CHOICE*... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate *HOW* the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet... noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle... would have suggested the combination." Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. [emphasis added]

Legal motivation is a sophisticated requirement under the stringent requirements of Section 103, and prevents the examiner from fabricating simplistic and broad reasons to combine references for any reason, as the present examiner has done.

The "whole" analysis mandated under Section 103 is another sophisticated requirement which prevents the examiner from selecting naked features from disparate references out of context, as the present examiner has again done.

It is quite clear that Smith expressly illustrates, expressly discloses, and, indeed, expressly recites in claim 1 a linerless label in which two strips of adhesive 34,35 are disposed along the opposite edges and are essential to the performance of the labels.

The examiner has identified nothing in Smith to the contrary.

The examiner has failed to identify any problem in Smith for which any solution in Slagsvol would be relevant.

Instead, the examiner has merely fabricated a reason, any reason, to combine the disparate references "for the purpose of

forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43-44)."

And, what problem is being solved? And, where is that problem disclosed? And, how is that problem relevant to Smith?

That very reference to "Column 1, lines 43-44" merely states in the summary section that: "Tracing paper made in accordance with this invention can be easily and rapidly applied to and removed from an underlying surface."

This is a mere generality, a mere "broad conclusory statement" under Dembicza, and disregards the express problems not only in Smith, but in Slagsvol, itself.

Slagsvol discloses multiple forms of the tracing paper, including all five figures 1-5 in which the adhesive 2a,b,c,d,e,g,h runs along both edges of the paper, not along a single side.

So would not Slagsvol more appropriately teach two columns of the adhesive corresponding with the two strips of adhesive disclosed in Smith?

Why has the examiner selected only figure 6 of Slagsvol to the exclusion of the other, and greater number of, figures which teach away?

The answer is conspicuous: hindsight selective combination of naked elements without regard to context.

Of what relevance is the "for the purpose" contention presented by the examiner to the different embodiments disclosed in Slagsvol or in Smith?

Legal motivation is not a nebulous concept, but requires evidence and specificity in solving stated specific problems, not fabricated general problems.

"More easily and rapidly applied" the examiner proffers?

Where is the teaching in Smith of any problem therein for which this "solution" of the examiner would be relevant?

The two-strip adhesive labels in Smith appear quite well enough efficient at being "easily and rapidly applied," and the examiner has not shown otherwise.

The examiner's problem is contrived for the sole purpose of fabricating the latest rejection, without regard to the stringent

requirements under Section 103 and the MPEP.

The well apparent feature of the tracing paper for effecting the "rapid and easy" function proffered by the examiner is nothing more than adequate adhesive as expressly disclosed in Slagsvol at col. 2, ll. 26+.

Slagsvol provides no relevant distinction between the dual strips of adhesive shown in figures 1-5 and the single strip shown in figure 6, and, indeed, the Detailed Description in Slagsvol is completely devoid of any reason for the single strip disclosed in figure 6; and the examiner has not shown otherwise.

And, the figure 6 embodiment in Slagsvol would appear to be against the very teachings thereof since one strip of adhesive would appear to effect the "loose fit" found problematic by Slagsvol itself, whereas the two strip adhesive would appear to reduce the "loose fit" problem.

Furthermore, the single strip adhesive of Slagsvol has no disclosed nexus with the two strip configurations taught by Smith, or, more importantly, to the "printable release" problem expressly stated therein and "not interfering with the thermal transfer function."

Accordingly, there is no legal motivation to combine Slagsvol and Smith in any manner, let alone the requisite manners required for the many claims being rejected in toto.

The examiner's "obvious" contention is classic hindsight reconstruction without regard to the express claim language and without regard to the whole of the claims and the two references being applied. It is a mere conclusion divorced from context.

At page 12, the examiner addresses the "improper hindsight reasoning" by citing McLaughlin without any stated reasoning at all.

The examiner cites McLaughlin for taking "into account only knowledge which was within the level of ordinary skill," but the examiner has failed to explain this, has failed to identify evidentiary support for specific features and specific cooperation, and has failed ab initio to provide any legal motivation whatsoever, which is not the same as hindsight examiner assertion.

The examiner again references "webster.com" for the definition of "label," but that reliance is not relevant to the Section 103 standard, and is nothing more than a generality lacking any nexus to the tests and requisite evidence.

The examiner blindly asserts "for the purpose of controlling the adherence of the substrate to a surface."

What does this mean?

Where is the evidentiary support therefor?

What problem is identified in Smith or Slagsvol for which this examiner-made "solution" would be relevant?

How does one adhesive strip "control adherence" any better than two strips, and how is this relevant to the specific problems in Smith or Slagsvol, or Applicants' problems in particular?

Of course, examiners, like the present examiner, are quite adept at fabricating rejections for any possible reason at all in the drive to reject claims under Section 103 in particular.

However, the MPEP and case law presented above for example, well recognizes this proclivity, and mandates a strict showing of evidence, and specificity in supporting rejections, and specific problem-solving analysis; and last, but not least, legal motivation based on evidence, not mere examiner assertion as this examiner has repeatedly proffered.

Dembiczak clearly states that "broad conclusory statements, standing alone are not 'evidence ...'." And, this examiner's repeated positions are nothing more than such "broad conclusory statements," without more.

#### CLAIMS 2 and 19

Claims 2 & 19 additionally recite that the column of patches 38 are aligned closer to one edge than the other.

The examiner admits the failure of Smith to so disclose, but then applies Slagsvol, yet again without due evidence or meeting the standards of Section 103.

The examiner references figure 6 of Slagsvol, but that figure discloses disparate tracing paper for different use, and Slagsvol fails to teach what problem the figure 6 species is solving or

relevant to.

The primary configurations and figures in Slagsvol all expressly teach two adhesive strips on opposite edges of the paper.

The examiner has chosen to select only the figure 6 species to the exclusion of the main figures in a self-evident use of hindsight without regard to reason.

"For the purpose of forming a paper that is easily and rapidly applied to a surface" has no evidentiary basis; has no relevance to any problem whatsoever, is inconsistent with the two-strip species in Slagsvol, and lacks any legal motivation.

**CLAIMS 3 and 19**

Claims 3 and 19 further recite the imperforate web 20.

Smith expressly teaches the lines of perforations 21.

And, Slagsvol expressly teaches the various perforated tear lines 5a-g.

The examiner has overlooked these features in these claims in the specific combinations recited therein, and has also overlooked the advantages of these claims as presented in the specification.

The examiner has therefore failed to establish even a *prima facie* showing.

**CLAIM 4**

Claim 4 recites the patches 38 with straight edges parallel with the running axis 32 as disclosed in the specification for specific benefit.

The examiner cites figure 2 of Smith, which is a transverse cross section failing to provide the required evidentiary support.

And, the examiner's use of figure 3 of Smith does not include the adhesive strips 34,35.

And, most importantly, the examiner is not using the continuous adhesive strips 34,35 of Smith by express admission, but instead is using the general disclosure of discontinuous strips, dots, polygons, and other patterns, none of which is shown

or described, leaving only to speculation what is intended by Smith.

CLAIM 5

Claim 5 recites the transverse straight edges of the patches 38B,C illustrated in figures 6 & 8, and correspondingly disclosed in the specification for benefit.

Yet again, the examiner has simply applied figure 3 of Smith, which figures does not show the adhesive strips, but which strips 34,35 from figure 2 would more than likely not have any transverse edge at all since they are clearly disclosed as continuous.

As for the discontinuous strips, dots, polygons, and other patterns being applied by the examiner, they are not shown or otherwise disclosed, and there is no evidence that they meet the stringent standards under Section 103 for supporting the rejection.

CLAIM 6

Claim 6 recites the rectangular patches 38B,C disclosed in the specification for particular benefits, and the examiner yet again refers specifically to figure 3 of Smith which does not show the adhesive strips 34,35 at all.

The strips 34,35 are expressly continuous, and clearly do not conform with a column of rectangular patches corresponding with the labels.

And, the examiner has failed to show that any of the alternate strips, dots, polygons, patterns would meet the rectangular features of claim 6 in the specific cooperation recited therein.

CLAIM 7

Claim 7 recites the elongate patches 38 along the running axis.

Yet again, neither figure 2 nor figure 3 of Smith being

applied by the examiner has any relevance to this species.

The strips 34,35 in Smith are clearly continuous, and the alternate configurations of strips, dots, polygon, and patterns all fail to disclose or suggest elongate patches along the running axis.

To the contrary, all of those patterns could just as well be elongate transversely to the running axis; and speculation cannot support a rejection under Section 103.

CLAIMS 8 and 15

Claims 8 and 15 introduce the index marks 42 between the patches 38 to define individual labels 12 having a single adhesive patch.

The examiner's reference to "Figure 3, #19" has no relevance to these claims, and fails ab initio to meet the stringent requirements of Section 103.

Figure 3 of Smith shows six registration marks 19 located along the silicone strips 27,28 and along the perf lines 21 without any disclosed nexus with the continuous strips of adhesive 34,35 shown only in figure 2, not figure 3.

The strips 34,35 are not patches, and the alternate strips, dots, polygons, and patterns are neither illustrated nor explained, and, at best, might be in uniform patterns corresponding with the strips 34,35 without any regard whatsoever for the registration marks 19 and the corresponding labels 11.

Claims 8 & 15 recite a single patch in each label, and there is no such disclosure or teaching in Smith, or in Slagsvol, and the examiner has not shown otherwise.

This rejection is a clear example of the examiner's failure to afford any weight to any feature in any claim, notwithstanding the specificity of those claims and features therein in the special combinations thereof.

No weight.

The examiner has clearly prejudged the application, and is determined to reject any claim for any reason, all in the guise of "obviousness" based on the mere assertion of "for the purpose."

No patent application could pass this subjective standard of the examiner based solely on hindsight and generality, and not based on the specificity required under the MPEP.

The examiner's entire basis for rejection of each and every claim is that because Smith incidentally discloses alternate patterns of the adhesive strips 34,35, then any and all claims to any and all patterns of adhesive would be per se obvious.

No patent would from here on be issued for any label application because any relevant label is nothing more than adhesive on a substrate and because Smith has adhesive on a substrate, subject to various "patterns" thereof, then ipso facto all label claims would have been obvious.

This bald position by the examiner is clearly not supported by the law; and the continuing error in the examiner's position is made even more evident as the additional species claims are being rejected by the examiner without regard to the substance or whole thereof.

#### CLAIM 9

Claim 9 recites the patches 38C being elongate transverse to the running axis as shown in figure 8, and the examiner admits at page 4 that Smith does not disclose this.

The examiner then compounds the errors of rejection in the paragraph bridging pages 4 and 5. All of the species being addressed by the examiner have been clearly overlooked by the examiner, as based on the mere contention that "the application does not indicate any new, significant attributes ...."

The specification is replete with benefits attributable to the recited columnar adhesive label including, for example, para 35.

This was previously presented to the examiner multiple times, and the examiner has repeatedly failed to answer those benefits as mandated by MPEP 707.07(f), and has conspicuously failed to address these species claims individually as required by MPEP 706.02(j).

All species claims recited have due description in the

specification, quite unlike the figure 6 species in Slagsvol, and corresponding benefits overlooked by the examiner in the rush to reject the claims based on disparate references, with, indeed, Slagsvol being nonanalogous both legally under the MPEP and substantively.

Paras. 46-48, conspicuously overlooked by the examiner explain the benefits (the whole) of these species for variable label size and avoidance of adhesive buildup.

Paras. 49 & 50 summarize advantages and benefits of the species claims, yet again overlooked by the examiner.

The examiner's failure to consider these claims and their features in the whole is an admission undermining any attempt to support the rejection thereof under Section 103.

The examiner's attempt at page 5 to cite Seid and Dailey from MPEP 2144.04 fails to comply with the basic requirements of case law precedent.

The examiner has failed to establish any factual similarity or nexus for applying these cases.

The examiner's initial need to combine two different references, Smith and Slagsvol, is evidence against the use of these two cases which address the mere change of shape or ornamental features without mechanical function.

The examiner's general statement that "Smith teaches a variety of shapes ..." fails to consider those "shapes" in the whole, or present any basis under Section 103 to reject the specifically recited claims and combinations thereof.

The Cols. 3-4 reference by the examiner deals solely with continuous or other patterns having no functional nexus identified by the examiner (See Seid, cited by the examiner).

The Col. 3, ll. 42-46, reference by the examiner applies to the silicone patterns 27,28; and not the continuous adhesive, and are further evidence of examiner error and the failure to properly evaluate the claims and references in the whole.

The examiner has failed to show how the "discontinuous strips, dots, a series of polygons, or a wide variety of other patterns" of Smith are in any way relevant to Applicants' species claims being rejected, or to the disparate configurations of

Slagsvol.

"The application does not indicate any new, significant attributes of the invention due to its shape ...?"

What are Applicants' express problems? They are repeated above.

What are Applicants' express solutions? They are contained in the various claims.

Claim 9 recites the transverse elongate patches for label variability and reduction of adhesive buildup. Why is this not "new or significant?"

Where does Smith or Slagsvol have any relevant teaching in this regard?

Where is any evidence of the "old" teaching of any structure in Smith or Slagsvol which would reduce adhesive buildup in a printer, or permit variable length labels?

The fundamental teaching of Smith is constant length labels 11 having the perf lines 21; and continuous adhesive strips 34,35 which would, without any doubt, cause adhesive buildup in a printer and on the cutting blade.

Similarly, the tracing paper of Slagsvol also has a constant length, and would also be subject to adhesive buildup if it could in fact be used in a printer having a cutting blade.

The examiner's use of MPEP 2145 at page 13 of the office action fails to afford any weight to the very evidence presented in Applicants' specification.

"Unexpected results" the examiner opines, but the examiner fails to afford any weight to the species claims and their benefits and "unexpected results" as expressly presented in the specification.

The species claims are not supported by mere "arguments" as the examiner contends in attempting to apply MPEP 2145; but are based on expressed statements in the specification.

The examiner on the one hand merely contends that Applicants present mere "arguments" which cannot take the place of evidence; but, on the other hand this is exactly what the examiner has done; made argument after argument based on mere examiner argument without any supporting evidence.

The examiner is quick to find fault in Applicants' claims and Applicants' specification, but the examiner fails to recognize the fundamental errors being presented by the examiner in the numerous mere examiner assertions, which are not evidence, nor do those assertions conform with the stringent evidentiary requirements under Section 103.

At page 13, the examiner makes quite clear, yet again, that "It would have been obvious ... to change the shape ... as Smith teaches a variety of shapes being used ...."

In other words, no label with any adhesive pattern will ever more be patentable by this examiner in view of these general teachings of Smith.

This is clear error; and the examiner has cited no legal support for that bald contention, and the broad license to reject all label claims regardless of the specific patterns of adhesive recited therein based on the mere "variety of shapes."

**CLAIM 11**

Claim 11 recites a plurality of the patches 38 in each label, in a combination again overlooked by the examiner.

Smith clearly teaches a continuous adhesive strip 34,35 bridging the series of labels 11.

Where is any teaching to divide the continuous strip 34,34 into multiple strips, dots, polygons, patterns for each of the labels 11.

Each claim is entitled to the full examination mandated by the MPEP under Section 103, and the examiner's continued practice of overlooking individual claims and the cooperation of elements recited therein is per se erroneous, and fails to establish a *prima facie* showing.

**CLAIM 12**

Claim 12 recites the arcuate edge species of the patches as shown in figures 1-4, 5 and 7.

At page 4, the examiner admits the failure of Smith to

disclose this and other species, and then merely applies Seid and Dailey as traversed above, without affording any weight to the specific benefits and "new, significant attributes" presented in the specification.

This quite erroneous position of the examiner is repeated at page 12, which emphasizes the examiner's failure to afford any weight whatsoever.

The arcuate species of claim 12 is disclosed at paras. 37 & 38 for example, and distributes the adhesive forces on the rollers in the printer in reducing adhesive buildup therein.

Where is any of this disclosed or suggested by Smith and Slagsvol in support of what the examiner contends is "old," when no such evidence is found in any reference to support the examiner's bald contention?

The examiner well recognizes that mere argument alone is not evidence; yet the examiner repeatedly merely argues the basis to reject claims without evidentiary or legal support, and even disregards the clear teachings and the clear evidence presented expressly in Applicants' specification.

In that regard, the examiner contends at page 11 that limitations from the specification will not be read into the claims; yet when limitations, e.g. arcuate, are indeed recited in the claims, the examiner nevertheless affords no weight thereto whatsoever as failing to provide new and unexpected benefits.

This the examiner again does without any reference to the specification itself, or the express teachings, benefits, and attributes presented therein.

The examiner thusly presents an impossible standard in failing to afford due weight to express claim language, and then failing to afford any weight to the description in the specification, because that description is not found in those very claims.

An impossible standard.

A standard which finds no room for the "whole" analysis, with the examiner clearly failing to afford due weight to not only the specific claim features and combinations, but also failing to afford any weight to the benefits expressly presented in the

specification.

CLAIM 13

Claim 13 recites the convex leading and trailing edge species as also presented at paras. 37 & 38 for example; and paras. 49+ summarize benefits of the various species.

Neither Smith nor Slagsvol disclose or suggest the column of adhesive patches having convex leading and trailing edges, and the examiner has not shown otherwise in the attempt to use the mere "variety of shapes" as the sole basis to reject every conceivable shape irrespective of combination in Applicants' claims and irrespective of the problems being solved.

CLAIM 14

Claim 14 recites the oval species of the adhesive patches 38 shown in figure 4, and yet again the examiner admits at page 4 that Smith fails to disclose this species, but simply contends that such species would nevertheless be obvious in view of the "variety of shapes" found in Smith.

Yet again, this rejection is clearly erroneous for want of evidence, analysis, and legal motivation.

Neither the strips, dots, polygons, or other patterns disclosed in Smith are either arcuate, convex, or oval in the different combinations recited in claims 12-14, and the examiner has not shown otherwise.

A "variety of patterns" is a mere "broad conclusory statement" proffered by the examiner in a technical vacuum, and without any regard, let alone due regard, to the express teaching of Smith at col. 4 for the type of adhesive or security of the bond.

CLAIM 17

Claim 17 recites the narrow release strip 40B shown in figure 7 and disclosed at para. 45 for the stated benefits, yet again

overlooked by the examiner.

The examiner applies figures 2 & 3 of Smith, but overlooks that the examiner has first altered those figures to include not the continuous strip species of the adhesive 34,35 and cooperating silicone 27,28, but the discontinuous strip, dots, polygon, and other patterns.

Claim 17 recites the strip 40B of release, not a plurality of patches thereof, and the examiner has failed to recognize the differences in this claim over the proposed modification of Smith.

The Section 103 requirement mandates that the examiner address each and every feature of a single claim in the specific combination, and the examiner's rejections fail to do so, but instead address naked elements without regard to context.

#### CLAIM 18

Claim 18 recites the silicone form of the release strip 40, which is clearly not rendered obvious over the discontinuous strip, dots, polygons, and patterns being used by the examiner out of context.

Accordingly, reversal of the rejection of claims 1-9, 11-15, 17, and 18 under Section 103(a) over Smith and Slagsvol is warranted and is requested.

#### Ground 2

Ground (2) - whether claims 10 and 16 are unpatentable under 35 USC 103(a) over Smith, Slagsvol, and Lane?

Applicants traverse the rejection of these claims and request reversal of this rejection.

As indicated above, Slagsvol is nonanalogous art and is therefore unavailable in supporting the rejection under Section 103.

#### CLAIM 10

Claim 10 excludes the index marks, yet Smith expressly requires registration marks 19.

The examiner's use of Lane disregards that the lines of perforations 12 are just as much the equivalent of index marks as the registration marks 19 in Smith, and the examiner has not shown otherwise.

At page 14 of the office action, the examiner, in a remarkably inconsistent twist, now attempts to use Applicants' own specification to unduly limit the definition of "index marks," as somehow not including the perf lines 12 in Lane.

This is quite remarkable, and equally erroneous.

The examiner has had no trouble in broadly defining recited elements, of course in the attempt to support a rejection.

But now, the examiner takes the contradictory approach to narrow recited elements, yet again, of course, in another attempt to support a rejection.

Neither logic nor law nor the MPEP support the examiner's contradictory positions, which contradictory positions merely add evidence to the examiner's conspicuous attempt to reject each and every claim for whatever reason imaginable.

Not one claim will this examiner allow: not one.

The examiner's use of para. 39 of Applicants' own specification is no support for limiting the definition of the recited index marks. That paragraph expressly states that "The index mark 42 may have various configurations, such as ...."

"Such as," is, of course, merely exemplary and inclusive not exclusive.

Perhaps the examiner could extend the patent search to determine what other forms of "index marks" can be found in the prior art, and which would be notoriously well known to those skilled in the art?

No, the examiner has not done this because the examiner has chosen to remain blind to the relevant prior art, and instead use the expedient to merely argue that the Applicants, themselves, are limiting the definition of "index marks" in the attempt to help the examiner reject the claims.

This is clear error.

The examiner has conspicuously overlooked the clear mandate of MPEP 2111.01 as a convenient expedient.

That provision states in part that "During examination, the claims must be interpreted as broadly as their terms allow," and are clearly not limited in interpretation by the specification.

It is clearly self evident that the perf lines 12 in Lane could indeed be used as index marks, if so desired in the prior art. Optical sensors are quite ubiquitous, and there can be no doubt that optical sensors could indeed detect the perf lines 12 in Lane even though they extend "through" the substrate as the examiner contends, and are detectable from both sides of the substrate.

The examiner's contentions on page 14 are clear evidence of the examiner's continued proclivity to assert anything for any reason in the attempt to support any rejection.

This is not objective, and this is not fair prosecution, and the accumulation of such assertions amounts to abuse of prosecution.

The examiner's bald contention of obviousness "to provide a continuous label without index marks" is without logic, without evidentiary basis, and without legal motivation, and is mere assertion.

Quite significantly, the examiner yet again applies Lane in a vacuum. The primary reference, Smith, being applied by the examiner clearly discloses the registration marks 19, and clearly states at col. 3, ll. 1+, the use thereof for being detected for specific function.

Yet, the examiner completely disregards those registration marks 19 without any recognition thereof, and merely asserts that Lane would teach the lack of index marks "that allows separation of individual labels ...."

Yet again, mere examiner argument or mere assertion without regard to the stringent requirements of Section 103.

The examiner's bald contention that Lane teaches the absence of index marks is not supported by any evidence therein, and the examiner's reference to "Page 3, Column 1, lines 15-20" has no relevance whatsoever to index marks or the lack thereof, but instead relates solely to the mere spacing of the gummed areas 11.

The examiner yet again offers no "legal motivation" as that

requirement is well explained in ch. 2100, but instead fabricates multiple and irrelevant reasons at pages 5 and 14, which could include many more irrelevant reasons, to combine the three disparate references.

**CLAIM 16**

Claim 16, and later claim 26, recites the full surface release strip in combination with the columnar adhesive patches completely overlooked by the examiner in the rush to reject.

At the top of page 6, the examiner cites Smith at "Column 3, line 60 to Column 4, line 1; Column 3, lines 42-46" for some alleged support for the equally irrelevant contention of "Smith discloses the use of discontinuous strips."

How is any of this relevant to claims 10 and 16?

What weight has the examiner afforded to the claim language recited therein?

How possibly could the "discontinuous strips" being proffered by the examiner support the rejection of full surface release strips which are not so discontinuous?

Clearly, the examiner is presenting naked arguments without regard to the accuracy or relevancy thereof, further poisoning the rejections of record.

And, the examiner is presenting arguments without regard to the clear inconsistency thereof.

The examiner previously applied Smith for the narrow silicone strips 27,28 in rejecting claim 17; but now, takes the contradictory position that the full coverage release strip recited in claim 16 would just as well be obvious because the disparate reference Lane discloses yet another "variety" of gummed band to supplant the basic teachings of Smith.

The examiner has failed to establish any technical or logical nexus between the three disparate references; and the examiner's use of these disparate references is further evidence of the failure to consider not only the claims in the whole, but the references in the whole as well.

The selective combination of the three references being

proffered by the examiner is conspicuous for the surgical precision that the examinee must employ to select naked elements to the exclusion of other elements and other embodiments, all without any legal motivation whatsoever.

The examiner merely opines "It would have been obvious ... in order to cut each band from a coated sheet without gumming the cutting knife ... since the modified Smith discloses the use of discontinuous strips...."

But, where are any problems being solved in Smith and Slagsvol for which the examiner's "solution" from Lane would have any relevance.

In Smith, so such "gumming" problem is disclosed or relevant; no printer or cutter are disclosed; and the perf lines 21 appear to allow separation of the labels 21 without the need for any cutter whatsoever.

In Slagsvol, the tracing paper, or "label" as redefined by the examiner, is used by hand for tracing graphics, and has no disclosed use in any printer whatsoever, which would defeat its intended use, and has no express "gumming" problem.

From the previous remarks presented above, it is quite clear that the examiner has failed to consider "problems" in their ordinary definition, webster.com or otherwise, and the gumming problem of Lane now being proffered by the examiner is found solely in the Lane reference due to the particular, and different, configuration thereof.

It is the examiner, working solely in hindsight, who has taken naked elements from Lane, and now attempts to force-fit them into Smith and Slagsvol in some unexplained combination without regard to the MPEP or Section 103 requirements.

The examiner is clearly using isolated disclosures from the three references without regard to the whole of the references or the whole of the claims.

The column 3-4 reference in Smith being used by the examiner expressly states that the adhesive strips 34,35 are continuous, yet still not full surface coverage; and being adhesive, they are irrelevant to the claim 16 recitation for the release strip.

The col. 3, ll. 42-46, reference by the examiner expressly

confirms that the silicone patterns 27,28 are continuous strips, and other patterns, but nevertheless are not full surface coverage.

The examiner's combination of Smith, Slagsvol, and Lane is clearly against the very teachings thereof, and is evidence in and of itself of the failure of the examiner to afford any weight, let alone due weight, to the combination claims being baldly rejected.

Accordingly, reversal of the rejection of claims 10 and 16 under Section 103(a) over Smith, Slagsvol, and Lane is warranted and is requested.

### Ground 3

Ground (3) - whether claims 19-25, 27-29, and 31 are unpatentable under 35 USC 103(a) over Smith and Slagsvol?

Applicants traverse the rejection of these claims and request reversal of this rejection.

Yet again, the examiner has merely copied verbatim in this new rejection presented in para. 7 of the final office action the fundamental contentions, including errors, found in para. 4.

Applicants therefore incorporate by reference the above traverse of the examiner's contentions regarding Smith and Slagsvol, including the nonanalogous nature of the Slagsvol reference in the first instance.

### CLAIM 19

Independent claim 19 is presented in detail in the summary section above, and includes basic features well distinguishable over Smith and Slagsvol as presented above.

Furthermore, claim 19 has been specifically written to introduce the printer 10 and cutting blade 28 in the preamble, with the body recited the specific configuration of the label roll and labels to permit transverse cutting of the web 20 by the blade 28 referenced in the preamble.

In this way, independent claim 19 adds expressly the further limitation of the printer, blade, and configuration in an attempt

to overcome the examiner's repeated failure to afford due weight to the features recited in the various claims, in the whole.

It appears from the examiner's contentions that the examiner will not afford any weight to any claim feature unless the features are expressly recited in the claims, irrespective of the description in the specification, or the benefits presented therein, or the whole significance of the claim.

However this attempt to placate the examiner has met with no avail.

At page 9, the examiner now contends that such features are merely "intended use" and the examiner has expressly failed to afford any weight thereto.

Yet again, this is clear error, and the examiner has failed to cite any legal precedent in failing to afford weight to these additional features in additional combination.

It is also clear that the examiner continues in the failure to afford due weight to the single column of noncontiguous adhesive patches 38 recited in independent claim 19 which extend along one lateral edge and cooperating with the adhesive-free spaces transversely bridging the web 20 to permit transverse cutting by the blade 28.

Since Smith discloses a "variety of shapes" the examiner continues to reject claims 19 et seq irrespective of the specific elements and specific combinations thereof.

This is more error.

In *In re Stencel*, 828 F.2d 751, 4 USPQ 2d 1071 (1987), the Federal Circuit restricted the scope and content of the prior art to only those devices capable of effecting the same purpose as the claimed invention. Claim 1 recited "A driver for setting a joint of a threaded collar ..., the driver comprising ...." The Federal Circuit stated that:

Appellant points out that the driver as claimed is indeed limited as to structure, the limiting structure being defined by the structure of the collar. For example, the driver is described in claim 1 as requiring: 'the minimum distance between each flat and the rotational axis corresponding substantially to the radius of the collar at the location of the lobes after their plastic deformation.'

As a matter of claim draftsmanship, appellant is not

barred from describing the driver in terms of the structure imposed upon it by the collar having plastically deformable lobes. The framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited... There is an extensive body of precedent on the question of whether a statement in a claim of purpose of intended use constitutes a limitation [citing *Kropa v. Robie*] ... Stencel is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue .... We conclude that it would not have been obvious to put the Grabovac flats in the Reiland driver unless one had in mind the purpose taught by appellant. This purpose, set forth in the claims themselves, 'is more than a mere statement of purpose; and that language is essential to particularly point out the invention defined by the claims.'

This case is legal support firstly for reference Slagsvol being nonanalogous art, but also for the claim construction practice of preamble and cooperating body features.

Slagsvol expressly teaches tracing paper, notwithstanding the examiner's characterization thereof as a "label," and that tracing paper is specifically configured and specifically intended for use by hand.

No printer, no cutting blade.

Accordingly, Slagsvol has no relevance to claim 19, including the label roll recited therein for use in the printer 10 having the cutting blade 28. Slagsvol is nonanalogous art; and Slagsvol teaches away.

MPEP 2111.02 contains guidance for the examiner on "intended use" and the examiner has failed to apply the provisions thereof.

Intended use is not *per se* objectionable, and the examiner's express failure to afford any weight to the preamble features in cooperation with the body features is erroneous *per se*.

The issue of a positive limitation or mere intended use is addressed in *Kropa v. Robie and Mahlman*, 187 F.2d 150, 152, 88 USPQ 478, 480-481 (CCPA 1951) as follows:

This court has often had before it the Jepson problem [citation omitted] - whether the preamble to claims in ex parte cases or to the counts in interference cases should be considered as limitations in the claims or counts. Of the

thirty-seven cases of this court we have reviewed with respect to this problem it appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause; or where the claim or count was drawn to a product and the introductory clause merely recited a property inherent in the old composition defined by the remaining part of the claim. In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter. On the other hand, in those ex parte and interferences cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or counts. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause so, as to distinguish the claim or count over the prior art.

Evaluating MPEP 2111.02, Kropa, and Stencel with regard to independent claim 19 will clearly show the structural definition provided by the preamble introduction of the printer 10 and its cutting blade 28, and the recited web 20 and labels 12 with isolated adhesive patches 38 permitting cutting by the blade in the adhesive-free spaces to resolve the adhesive buildup problem expressly presented in the Background.

These features, the examiner has failed to consider in the rush to apply mere "intended use."

As presented above, the examiner has failed to establish even a *prima facie* rejection of the claims, now including independent claim 19.

Smith fundamentally discloses the continuous adhesive strips 34,35 along both edges of the substrate 12, and those strips would clearly be cut by any cutting blade used in any printer.

Note, however, that Smith expressly teaches the perf lines 21 for separating the labels 11, and no teaching of using any printer

is found in Smith.

The "variety of shapes" being used by the examiner for the alternate configurations of the adhesive in Smith still lack any relevance to specifically formed adhesive-free spaces transversely bridging the web 20 to permit adhesive-free cutting by a blade.

Discontinuous strips, or dots, or polygons, or other patterns, without more, do not suggest the species recited in independent claim 19 for adhesive-free cutting.

The strips, dots, polygons, and other patterns must necessarily extend along the edges, both, of the substrate 12 in Smith "for the purpose of" securely bonding the final label to the substrate as taught at col. 5., ll. 1+.

In those configurations, it is more likely than not that the adhesive patterns extend transversely without longitudinal gaps "for the purpose of" effecting that secure bonding.

And, in that configuration, any transverse cutting would necessarily cut the adhesive, and subject any such cutting blade to undesirable adhesive buildup' which is Applicants' specific problem.

Since the examiner has expressly admitted the failure to consider independent claim 19 for all its features, citing intended use of the preamble features, the rejection under Section 103 is void ab initio, and must be reversed for want of evidence, want of analysis, and want of legal motivation.

#### CLAIM 20

Claim 20 recites the oval species of the adhesive patches 38, and the examiner's repeated use of Seid and Dailey, and the corresponding contentions found at page 8 of the office action are equally defective for the reasons presented above.

#### CLAIM 21

Claim 21 introduces the index marks 42 and single patch 38 labels. As indicated above, the examiner has failed to provide even a *prima facie* rejection of this claim since neither Smith nor

Slagsvol disclose or suggest this species, and especially since the adhesive strips 34,35 in Smith extend along both edges continuously, and the adhesive in Slagsvol similarly extends along the edges in continuous or multiple strips for the individual tracing sheets.

**CLAIM 22**

Claim 22 recites the narrow release strip 40B conforming in width to the adhesive column, and yet again the examiner's repeat of the previous contentions regarding claim 17 are without evidentiary or legal support in Smith, Slagsvol, and the MPEP.

**CLAIM 23**

Claim 23 recites the rectangular patch 38B,C species, and is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 6.

**CLAIM 24**

Claim 24 recites the elongate patch 38B species, and is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 7.

**CLAIM 25**

Claim 25 introduces in the preamble the index sensor 30; and then introduces in the body the index marks 42 which define the labels with single adhesive patches, and which labels are configured for cutting therebetween upon detection of the marks.

This claim is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 8; and furthermore because neither Smith nor Slagsvol disclose or suggest the configurations of their sheets for cooperation with an index sensor in the manner recited in this claim.

In Slagsvol, the tracing paper is used by hand, without

printer, without cutting blade, and without any need for index marks or sensors.

In Smith, the registration marks 19 are differently configured and differently used as expressly disclosed at col. 3, 11. 16+. Since the adhesive strips 34,35 are continuous in Smith, the registration marks lack any nexus to either that configuration thereof, or the alternate configurations thereof, including discontinuous, dots, polygons, and patterns; and the examiner has not shown otherwise.

**CLAIM 27**

Claim 27 recites the transverse elongate patch 38C species, and is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 9.

**CLAIM 28**

Claim 28 recites the plurality of adhesive patches in each label 12, and is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 11.

**CLAIM 29**

Claim 29 recites the narrow release strip 40B species, and is well distinguishable over Smith and Slagsvol for the reasons presented above for claim 17.

Furthermore, the examiner's contentions regarding these various dependent claims are additionally erroneous for the admitted failure by the examiner to afford any weight to the preamble features, which are also found in the bodies of these claims by express inclusion in additional cooperation with the additional features being introduced in the dependent claims.

The examiner's expedient to merely copy verbatim the bases of rejection previously presented results in the failure to consider *de novo* these different claims for their different combinations with the labels rolls configured expressly for being cut by the

blade in the printer.

The examiner may choose to disregard that cooperation, notwithstanding the requirement to nevertheless evaluate those claims in the whole; but the examiner cannot disregard that cooperation in independent claim 19 and its dependent claims which expressly recite the printer and cutting blade.

**CLAIM 31**

Independent claim 31 recites the label roll 18 in a new combination overlooked by the examiner, who, instead, has simply grouped claim 31 with independent claim 19. This is error.

In claim 31, the web 20 is imperforate as similarly recited in independent claim 19, but the examiner has failed to afford any weight to this feature in the rush to reject.

Smith expressly teaches the perf lines 21, which are clearly not imperforate.

Slagsvol similarly illustrates the perforated tear lines 5a-g, which, yet again, are not imperforate.

The imperforate feature is quite significant in evaluating the claims in the whole, because the claims recite a label roll 18 for use in a printer for printing individual labels 12, which labels are cut from the web, and are therefore subject to the adhesive buildup problem.

That problem is solved by the special configuration of the column of adhesive patches 38 with the adhesive-free spaces therebetween.

And, the imperforate web permits cutting the web into labels of different length.

In Smith, the perf lines 21 mandate constant length of the labels 11, and the adhesive strips 34,35 still subject any cutting blade which might be employed to undesirable adhesive buildup.

In Slagsvol, the tracing paper is shown in either a constant length stack, or roll, with the perforated tear lines 5a-g specifically provided for their use as manually positioned tracing paper without regard for any printer or cutting blade.

Claim 31 also recites a train of the adhesive patches 38

aligned in a single column along only one edge of the web 20 and isolated inboard in a surrounding adhesive-free remainder.

In Smith, the adhesive strips 34,35 run along both edges of the substrate 12, and are neither singular column patches, nor spaced inboard from those two edges.

In Slagsvol, the tracing paper has continuous adhesive along both edges, or multiple strips 2f in an individual tracing paper sheet.

Accordingly, reversal of the rejection of claims 19-25, 27-29, and 31 under Section 103(a) over Smith and Slagsvol is warranted and is requested.

**Ground 4**

Ground (4) - whether claim 26 is unpatentable under 35 USC 103(a) over Smith, Slagsvol, and Lane?

Applicants traverse the rejection of this claim and request reversal of this rejection.

**CLAIM 26**

Claim 26 recites that the release strip 40 covers the web front side 34 of the label roll in full.

As indicated above, Slagsvol is nonanalogous art, and is not available in any combination with Smith and the disparate reference Lane.

The examiner's basic combination of Smith and Slagsvol is erroneous for the same reasons presented above for claim 25 and its parents.

The examiner again admits that Smith and Slagsvol fail to disclose the "release strip covering said web front side in full."

The examiner's contentions on page 10 to combine Lane are the same as presented above at page 5 of the office action, and are equally erroneous as presented above.

The examiner again overlooks the fundamental differences in Smith, Slagsvol, and Lane; with Smith and Slagsvol have quite wide substrates, whereas the figure 1 species in Lane has a quite

narrow width.

Why waste expensive release material in Smith and Slagsvol by increasing the surface area thereof when no apparent benefit is taught?

The examiner's "for the purpose" presented at the top of page 10 lacks meaning and relevance. Of what relevance is the "low adhesive composition" on the back surface 13 in Lane to the sheet cutting "without gumming the cutting knife?" And, what significance does the examiner intend for "fusing together the edges of the resulting bands?"

What cutting in Smith and Slagsvol?

What fusing together of what resulting bands in Smith and Slagsvol?

In Smith, the individual labels 11 may be readily separated at the perf lines 21.

In Slagsvol, the tracing paper is provided in distinct sheets, or rolls, and has various perforated tear lines 5a-g for manual tearing.

At the paragraph bridging pages 14 & 15, the examiner repeats the use of Lane, with the mere conclusion that "the full release strip in the modified Smith [would have been obvious] in order to store the label ...."

Yet again, the examiner overlooks the whole of these references, and overlooks the narrow width of the back face 13 in Lane, and further (must) overlook the remarkably wide width of the substrate 12 in Smith. The examiner then simply opines that the entire surface of the Smith substrate 12 would have been coated with release for no apparent benefit, and without regard to the substantial added cost to so coat the substrate.

Cost is a paramount economic factor in the real life manufacture of pressure sensitive labels, and this examiner would disregard such real life factors in adding expensive release material where it would serve no function whatsoever.

The two silicone strips 27,28 in Smith are quite adequate in their disclosed narrow widths to meet their intended purpose; and the examiner has not shown otherwise.

No, the examiner continues to show the proclivity to reject

each and every claim without due regard to the merits thereof, and without regard to well established examination practice as well presented in the MPEP.

The examiner's final rejection of dependent 26 compounds the errors of rejection, as well evidenced by the distortions expressly in the examiner's mere arguments.

Accordingly, reversal of the rejection of claim 26 under Section 103(a) over Smith, Slagsvol, and Lane is warranted and is requested.

As for the examiner's additional remarks contained in the "Response to Arguments" paragraph 9, those contentions are traversed in full, and have been addressed above for the corresponding claims.

Conclusion

Not one claim has the examiner allowed; not one.

It is clear that the examiner, and supervisor, have prejudged this application, and prejudged the claims, and are working in hindsight to fabricate rejections without regard to express claim features or the cooperation thereof, or the whole of the claims when read in light of the specification, or the whole of the disparate references being applied.

Nothing added to the claims in the many, many attempts to accommodate the examiner's subjective interpretation of the patent law has been effective to overcome the examiner's continued position that because the fundamental reference Smith incidentally discloses, but does not show or describe, a "variety of shapes" then any and all shapes for not only the silicone strips, but the adhesive strips would have been obvious *per se*.

This position of the examiner is erroneous, and now it is up to the Board to evaluate the examiner's rejections *de novo*, and determine whether even *prima facie* showings have been made for each claim under each ground of rejection in the stringent manner mandated by MPEP 706.02(j) and Section 103, including the identification of specific evidence to support the many recited features, and further including "legal motivation" as well

presented in MPEP ch. 2100, in contradistinction from mere examiner arguments, mere examiner "for the purpose," and mere examiner "therefores."

For these exemplary reasons, reversal of all the various rejections is warranted, and allowance of all claims 1-29 and 31 is warranted and is requested.

Respectfully submitted,



Francis L. Conte, Attorney  
Registration No. 29,630

Date: 19 March 2007

6 Puritan Avenue  
Swampscott, MA 01907  
Tel: 781-592-9077  
Fax: 781-592-4618

Attachments:

1. Claims Appendix
2. Evidence Appendix
3. Related Proceedings Appendix

CLAIMS APPENDIX

Claims on appeal:

1. A label roll comprising:

a web having a front surface and an opposite back surface wound longitudinally along a running axis in a roll having a plurality of labels;

said back surface including a plurality of noncontiguous adhesive patches spaced longitudinally apart in a column of adhesive isolated on one side only of the transverse middle of said web in a minor area of said back surface, with the remaining area of said back surface being devoid of adhesive and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels; and  
said front surface including a release strip extending along said running axis behind said column of adhesive patches, and laminated to said patches in successive layers in said roll, with said patches being sized for bonding an individual label to a surface.

2. A roll according to claim 1 wherein said patches are aligned along one lateral edge of said web, and closer thereto than to an opposite lateral edge of said web.

3. A roll according to claim 2 wherein said web is continuous along said running axis, and imperforate.

4. A roll according to claim 2 wherein said patches have straight edges aligned parallel with said running axis.

5. A roll according to claim 2 wherein said patches have straight edges extending transversely with said running axis.

6. A roll according to claim 2 wherein said patches are

rectangular.

7. A roll according to claim 6 wherein said patches are elongate along said running axis.

8. A roll according to claim 7 wherein said web further includes corresponding index marks between adjacent patches to define corresponding labels, each label having a single adhesive patch.

9. A roll according to claim 6 wherein said patches are elongate transverse to said running axis.

10. A roll according to claim 9 wherein said web is devoid of index marks between said patches.

11. A roll according to claim 9 wherein each of said labels has a plurality of said adhesive patches.

12. A roll according to claim 2 wherein said patches have arcuate edges extending transversely with said running axis.

13. A roll according to claim 2 wherein said patches have convex leading edges, convex trailing edges, and straight side edges extending therebetween.

14. A roll according to claim 2 wherein said patches are oval, with major axes disposed parallel to said running axis.

15. A roll according to claim 14 wherein said web further includes corresponding index marks between adjacent patches to define corresponding labels, each label having a single adhesive patch.

16. A roll according to claim 2 wherein said release strip covers said web front side in full.

17. A roll according to claim 2 wherein said release strip is narrow and conforms in width with said column of adhesive patches, leaving the remainder of said web front side devoid thereof.

18. A roll according to claim 2 wherein said release strip comprises silicone coating said web front surface.

19. A label roll for use in a printer having a cutting blade, comprising:

an imperforate web having a front surface and an opposite back surface wound longitudinally along a running axis in a roll having a plurality of labels;

said back surface including a plurality of noncontiguous adhesive patches aligned in and spaced longitudinally apart along a single column of adhesive patches extending along said running axis of said web closer to one lateral edge of said web than to an opposite lateral edge of said web, with adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit transverse cutting of said web by said blade in said adhesive-free spaces to separate said labels; and

said front surface including a release strip extending along said running axis behind said column of adhesive patches, and laminated to said patches in successive layers in said roll, with said patches being sized for bonding an individual label to a surface.

20. A roll according to claim 19 wherein said patches are oval, with major axes disposed parallel to said running axis.

21. A roll according to claim 20 wherein said web further includes corresponding index marks between adjacent patches to define corresponding labels, each label having a single adhesive patch.

22. A roll according to claim 21 wherein said release strip is narrow and conforms in width with said column of adhesive patches, leaving the remainder of said web front side devoid thereof.
23. A roll according to claim 19 wherein said patches are rectangular.
24. A roll according to claim 23 wherein said patches are elongate along said running axis.
25. A roll according to claim 24 wherein said printer includes an index sensor and said web further includes corresponding index marks detectable by said sensor and disposed between adjacent patches to define corresponding labels, each label having a single adhesive patch.
26. A roll according to claim 25 wherein said release strip covers said web front side in full.
27. A roll according to claim 23 wherein said patches are elongate transverse to said running axis.
28. A roll according to claim 27 wherein each of said labels has a plurality of said adhesive patches.
29. A roll according to claim 28 wherein said release strip is narrow and conforms in width with said column of adhesive patches, leaving the remainder of said web front side devoid thereof.
31. A label roll comprising:  
an imperforate web wound longitudinally in a roll; and  
said web including a train of longitudinally separated identical adhesive patches on one surface and a different release strip on an opposite surface behind said train, with said patches being aligned in a single column along only one

lateral edge of said web to define corresponding labels each having a minor adhesive patch isolated inboard in a surrounding adhesive-free remainder of each label, with said adhesive-free remainder transversely bridging said web longitudinally between said patches to permit adhesive-free cutting of said web to separate said labels.

**EVIDENCE APPENDIX**

In accordance with 37 CFR 41.37(c)(1)(ix), there is no additional evidence submitted by the Appellants pursuant to 37 CFR 1.130, 1.131, or 1.132, or any other evidence entered by the examiner and relied upon by Appellants, other than the evidence relied upon by the examiner as to the grounds of rejection to be reviewed on appeal.

**RELATED PROCEEDINGS APPENDIX**

In accordance with 37 CFR 41.37(c)(1)(x), there is no decision rendered by a court or the Board in any proceeding identified pursuant to paragraph 37 CFR 41.37(c)(1)(ii).